IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Scott Campbell
APPLICATION NO.:	10/691,929
TITLE:	System and Method for Recording and Displaying a Graphical Path in a Video Game
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EXAMINER:	Omkar A. Deodhar
ATTY. DKT. NO.:	PA2587US

MAIL STOP APPEAL BRIEF
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

BRIEF ON APPEAL

REAL PARTY IN INTEREST

The real party in interest is Sony Computer Entertainment America LLC, by way of merger with Sony Computer Entertainment America Inc. by way of assignment from the named inventor of the present application.

RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences.

STATUS OF THE CLAIMS

Claims 1-24 and 26-30 are presented for appeal. Claim 25 has been cancelled. Claims 1-24 and 26-30 have all been twice rejected.

STATUS OF AMENDMENTS

All previously presented amendments have been entered into the record.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Each of the independent claims generally recites a system or method for displaying a

graphical path. [0001], [0011]. Graphical path data associated with a previous run is

retrieved. [0015]-[0017]. The graphical path data is displayed as a visual string of path

markers. [0017]. A color for a displayed path marker of the visual string of path

markers is determined based upon an elapsed time from a starting point to a current

location of a player character of a current video game session and an elapsed time from a

starting point to the current location of the player character associated with the

displayed path marker from the previous run and recorded for each point in the path,

wherein the current location is after the starting line but prior to the finish line for a

course being traversed in the current video game session. [0017]-[0019], [0025], [0026],

[0029], [0031]-[0035].

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Does a Rule 131 declaration have to comply with 37 CFR 1.47(b)?

ARGUMENT

On December 2, 2008, the U.S. Patent Office issued a non-final office action wherein the independent claims of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over, *inter alia*, U.S. patent number 7,214,133 to Jen et al., which was filed in the United States on May 9, 2003. On June 2, 2009, the Applicants submitted *Response E*, which submitted that "[t]he Jen et al. reference is not eligible for the purpose of rendering a rejection under 35 U.S.C. § 103(a). Jen et al. (outside the aforementioned obviousness rejection) can only qualify as prior art against the present application under 35 U.S.C. § 102(e)." *Response E*, 8. The Applicants further submitted that the presently claimed invention was actually reduced to practice prior to April 8, 2003, which was prior to the filing date of the Jen et al. reference. *Id.*

On October 29, 2009, the Examiner refused to accept *Response E* and its concurrently submitted Rule 131 declaration for (1) failing to comply with Rule 47(b) and (2) contesting certain dates and postings referenced in the Rule 131 declaration. See *October 2009 Rejection*, 2. A notice of appeal was subsequently filed on April 9, 2010. On August 24, 2010, the Applicants submitted a *Request for Continued Examination* including an information disclosure statement identifying a Japanese reference to Namco Ltd. and a rejection from the European Patent Office for an application claiming the priority benefit of the present application. A new final office action followed on September 1, 2010 that repeated "the previous Office Action [*i.e.*, the October 29 rejection] . . . *in toto*." *September 2010 Rejection*, 2. The present response is considered responsive to the October 2009 and September 2010 rejections in that it addresses the Examiner's refusal to accept the previously submitted Rule 131 declaration, which disqualifies the Examiner's use of the Jen reference, and, consequently, obviates the Examiner rejection under 35 U.S.C. § 103(a).

The Examiner first contends that "the affidavit is not compliant with the requirements in 37 CFR 1.131" because "it must also be in compliance with 37 CFR 1.47(b)." *October 2009 Rejection*, 2. The Applicants respectfully disagree as Rule 47(b) concerns the situation "[w]henever all of the inventors refuse to **execute an application for patent**" whereby" a "person to whom an inventor has assigned or agreed in writing to assign the invention . . . may **make application for patent on behalf of and as agent for all the inventors.**" 37 C.F.R. § 1.47(b). A declaration under 37 C.F.R. § 1.131 is not an application for or an execution of an application for patent.

The Applicants note that Rule 131(a) states that:

> [w]hen any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim . . . or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

A party qualified under 37 C.F.R. § 1.47 includes "a person to whom an inventor has assigned"—that is, the <u>assignee of the present application</u>. The <u>assignee of the present application</u> designated a person who is "thoroughly familiar with the subject matter, claims, and prosecution history of the present application" and that can "readily and freely testify as to the same." *Declaration Pursuant to 37 C.F.R. § 1.183 & 37 C.F.R. § 1.131,* ¶ 1. Nowhere in Rule 131 is there a requirement that an applicant satisfy the requirements for an inventor that refuses to execute an application; Rule 47 is referenced only in that a "party qualified" under said rule may make said declaration.

Nor does MPEP § 715.04, which governs practice under Rule 131, impose any such requirement as suggested by the Examiner in the October 2009 rejection. MPEP 715.04(I) states—as to *who* may make a declaration under Rule 131—that "[t]he assignee or other party in interest . . . may make an affidavit or declaration under 37 CFR 1.131 . . . when it is not possible to produce the affidavit or declaration of the inventor." MPEP §

715.05(I)(D). The Applicants therefore contend that the Examiner has imposed requirements on a Rule 131 declaration that are not required by the Office.

Further, the Examiner contends that the evidence provided with the declaration is not persuasive. *October 2009 Rejection*, 3. For example, the Examiner contends that paragraph 13 of the declaration fails to establish actual reduction to practice. While the press release in and of itself does not establish reduction to practice, the press release should be considered in the context of the other evidence presented to establish reduction to practice. For example, it is unlikely that a company would announce the forthcoming commercial release or demonstration of a product when, in fact, it is not imminently read for commercial release or demonstration. This is especially true when the press release was made a little more than a month from the public display of the product at one of the world's largest video game expositions—the E3 Conference is Los Angeles (see paragraph 15). And as further indicated in paragraph 15, while that commercial / public release of the product was four days after the filing date of the reference in question, common sense requires that a video game—which takes years to develop—cannot be conceived of, developed, coded, and debugged with a 4 day time frame. The press release that pre-dated the Jen reference coupled with the product release that followed the Jen reference by a mere 4 days requires the adoption of common sense that the product was conceived of prior to Jen.

Still further, paragraph 14 provides video evidence of the actual release of the Downhill Domination product. The Examiner contends, however, that "web-links change over time." *October 2009 Rejection*, 3. While this is possible (theoretically), there is no evidence that this is the case. This possibility, too, calls into serious question *why* someone would change the links concerning the state of game development at a certain date with a different video *after the fact* when that new video would be inaccurate. The Examiner's rejection, therefore, is based in inherency or mere possibility. If that is the case, then the Applicant contends that the proper basis for establishing inherency has

not been met as mere possibility does not meet the standard set forth by the Manual of Patent Examining Procedure and the various Board and Federal Circuit decisions that have since interpreted the same.

CONCLUSION AND REQUESTED RELIEF

The Applicant's representatives have evidenced that the presently claimed invention was actually reduced to practice prior to the filing date of the Jen et al. reference. Jen et al. is, therefore, not prior art against the present application. Absent the Jen et al. reference, the Examiner has failed to disclose the presence of each and every element of the presently claimed invention in the prior art. The Examiner, therefore, has failed to make a *prima facie* case of obviousness and the rejection is overcome.

The Applicant respectfully requests the passage of the present application to allowance. The Examiner is invited to contact the Applicant's undersigned representative with any questions concerning this matter.

Respectfully submitted,
Scott Campbell

May 7, 2011   By: /Tam Thanh Pham/
                                          Tam Thanh Pham (50,565)
                                          Carr & Ferrell *LLP*
                                          120 Constitution Drive
                                          Menlo Park, CA 94025
                                          T: 650.812.3400
                                          F: 650.812.3444

CLAIMS APPENDIX

THE PENDING CLAIMS ARE AS FOLLOWS:

1. (previously presented) A method for displaying a graphical path in a video game, comprising:

 retrieving graphical path data associated with a previous run;

 displaying the graphical path data as a visual string of path markers; and

 determining a color for a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of a current video game session and an elapsed time from a starting point to the current location of the player character associated with the displayed path marker from the previous run and recorded for each point in the path, wherein the current location is after the starting line but prior to the finish line for a course being traversed in the current video game session.

2. (previously presented) The method of claim 1, wherein determining the color for a displayed path marker includes selecting a first color for the displayed path marker when the elapsed time associated with the displayed path marker is greater than the elapsed time of the current video game session.

3. (previously presented) The method of claim 2, wherein determining the color for a displayed path marker includes selecting a second color for the displayed path marker based upon a character state associated with the displayed path marker when the elapsed time associated with the displayed path marker is less than or equal to the elapsed time of the current video game session.

4. (previously presented) The method of claim 3, wherein the character state associated with the displayed path marker is an "on the ground" state.

5. (previously presented) The method of claim 3, wherein the character state associated with the displayed path marker is an "airborne" state.

6. (previously presented) The method of claim 3, wherein the character state associated with the displayed path marker is a "crashed" state.

7. (previously presented) The method of claim 1, wherein determining the color for a displayed path marker includes selecting a color based upon a character state associated with the displayed path marker.

8. (original) The method of claim 1, wherein the previous run is a "best time" run.

9. (original) The method of claim 1, wherein the previous run is a "worst time" run.

10. (original) The method of claim 1, wherein the previous run is an "average time" run.

11. (original) The method of claim 1, wherein the previous run is a run selected from one or more previous runs.

12. (original) The method of claim 1, further comprising generating current graphical path data associated with the current video game session.

13. (previously presented) The method of claim 12, further comprising storing the current graphical path data as "best time" run graphical path data when a total elapsed time of the current video game session is less than a total elapsed time associated with a previous "best time" run.

14. (previously presented) The method of claim 12, further comprising storing the current graphical path data as "worst time" run graphical path data when a total elapsed time of the current video game session is greater than a total elapsed time associated with the previous run.

15. (original) The method of claim 12, further comprising utilizing the current graphical path data in determining an "average time" run graphical path data.

16. (previously presented) The method of claim 1, wherein the visual string of path markers are generated at a substantially equal-distance from each other.

17. (previously presented) The method of claim 1, wherein retrieving graphical path data includes retrieving the graphical path data associated with the previous run from a data cache.

18. (previously presented) The method of claim 1, wherein retrieving graphical path data includes retrieving the graphical path data associated with the previous run from a memory card.

19. (previously presented) A computer readable storage medium having embodied thereon a program, the program being executable by a processor to perform a method for displaying a graphical path in a video game, the method comprising:

retrieving graphical path data associated with a previous run;

displaying the graphical path data as a visual string of path markers; and

determining a color for a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of a current video game session and an elapsed time from a starting point to the current location of a player character associated with the displayed path marker from the previous run and recorded for each point in the path, wherein the current location is after the starting line but prior to the finish line for a course being traversed in the current video game session.

20. (previously presented) The computer readable storage medium of claim 19, wherein determining the color for the displayed path marker includes selecting a first color for the displayed path marker when the elapsed time associated with the displayed path marker is greater than the elapsed time of the current video game session.

21. (previously presented) The computer readable storage medium of claim 20, wherein determining the color for the displayed path marker includes selecting a second color for the displayed path marker based upon a character state associated with the displayed path marker when the elapsed time associated with the displayed path marker is less than or equal to the elapsed time of the current video game session.

22. (previously presented) The computer readable storage medium of claim 19, further comprising generating current graphical path data associated with the current video game session.

23. (previously presented) The computer readable storage medium of claim 22, further comprising storing the current graphical path data as the "best time" run graphical path data when a total elapsed time of the current video game session is less than a total elapsed time associated with a previous "best time" run.

24. (previously presented) An electronic entertainment system for displaying a graphical path in a video game, comprising:

a data cache configured to store graphical path data associated with a current video game session and a previous run;

a processor configured to execute instructions stored in memory to:

retrieve the graphical path data associated with the previous run,

to generate a visual string of path markers, and

to determine a color for a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of a current video game session and an elapsed time from a starting point to the current location of a player character associated with the displayed path marker from the previous run and recorded for each point in the path, wherein the current location is after the starting line but prior to the finish line for a course being traversed in the current video game session; and

a display device configured to display the visual string of path markers.

25. (cancelled)

26. (previously presented) The electronic entertainment system of claim 24, wherein the processor is configured to further execute instructions stored in memory to determine a color for a displayed path marker of the visual string of path markers based upon a character state associated with the displayed path marker.

27. (previously presented) The electronic entertainment system of claim 24, further comprising a memory card and coupled to the processor, the memory card configured to store graphical path data associated with the previous run.

28. (previously presented) The electronic entertainment system of claim 24, wherein the processor is configured to execute instructions stored in memory to:

        generate graphical path data of the current video game session; and

        store graphical path data of the current video game session in the data cache.

29. (previously presented) The electronic entertainment system of claim 24, wherein the processor is configured to further execute instructions stored in memory to store current graphical path data of the current video game session as "best time" run graphical path data when a total elapsed time of the current video game session is less than a total elapsed time associated with a previous "best time" run.

30. (previously presented) A system for displaying a graphical path in a video game session, comprising:

        means for retrieving graphical path data associated with a previous video game session;

        means for displaying the graphical path data as a visual string of path markers; and

        means for determining a color of a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of the video game session, an elapsed time from a starting point to the current location of a player character associated with the displayed path marker from the previous run and recorded for each point in the path, and a character state associated with the displayed path marker, wherein the current location is after the starting line but prior to the finish line for a course being traversed in the current video game session.